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09/750,142

12/29/2000

Stephane Bouet

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EXAMINER

PHAN, TAM T

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,142

Applicant(s)

BOUET, STEPHANE

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This application has been examined. Amendment received on 09/09/2004 has been entered. Claims 1 and 18 are currently amended. Claims 2-17 and 19-37 are previously presented. Claims 38-45 are newly added.

2. Claims 1-45 are presented for examination.

Priority

3. No priority claims have been made.

4. The effective filing date for the subject matter defined in the pending claims in this application is 12/29/2000 (29 December 2000).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reisman (U.S. Patent Number 6,594,692) in view of Fujimoto (U.S. Patent Number 6,018,720).

7. Reisman disclosed a media content delivery system comprising: a database for storing a plurality of media files; a user input device for selecting media files in said database to be outputted; an output device for outputting of selected media files; an external data interface for receiving media file (Abstract, Figures 1, 7, 12, column 10 lines 52-67).

8. Reisman did not expressly teach an integrated circuit card interface adapted to hold an integrated circuit card having encoded thereon criteria for accepting media files for storage in said database; and a controller responsive to selection by said user input device of one of the media files stored in said database, to apply the selected media file to said output device for outputting, and responsive to receipt by said external data interface of media files, to store in said media database only media files received, by said external data interface which meet criteria on an integrated circuit card held in said integrated circuit card interface.

9. Reisman suggested exploration of art and/or provided a reason to modify the delivery system with other storage devices such as the integrated circuit (IC) card to enable flexible and appropriate online service charging mechanism for online media products (column 2 lines 39-48, column 10 lines 52-67, column 29 line 62-67, column 62 lines 29-32).

10. Fujimoto disclosed an integrated circuit card interface adapted to hold an integrated circuit card having encoded thereon criteria for accepting media files for storage in said database (column 1 lines 34-43, column 2 lines 46-65, column 15 lines 51-67); and a controller responsive to selection by said user input device of one of the media files stored in said database, to apply the selected media file to said output device for outputting, and responsive to receipt by said external data interface of media files, to store in said media database only media files received, by said external data interface which meet criteria on an integrated circuit card held in said integrated circuit

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card interface (Abstract, Figures 1-2, column 2 lines 46-65, column 8 lines 30-48, column 13 lines 19-47, column 15 lines 51-67).

11. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the delivery system of Reisman with the teachings of Fujimoto to include the IC card feature in order to offer user greater flexibility because IC cards would have the function of checking authenticity and of storing data (Fujimoto, column 1 lines 34-42) since online services are oriented to extended online sessions which require complex user interaction (Reisman, column 2 lines 24-30). In addition, IC cards would also permit an online service provider to incorporate access fee into a purchase price or a product subscription (Reisman, column 2 lines 39-48) since an IC card has logical processing functions such as data generation and logical decision (Fujimoto, column 1 lines 34-43).

12. Regarding claim 2, Fujimoto disclosed a media content delivery system wherein said user input device comprises a keyboard (Figure 1 sign 4).

13. Regarding claim 3, Reisman disclosed a media content delivery system wherein said user input device comprises a mouse (column 22 lines 43-51).

14. Regarding claim 4, Reisman disclosed a media content delivery system wherein said user input device comprises an electronic interface (Figure 12).

15. Regarding claim 5, Reisman disclosed a media content delivery system wherein said output device comprises a video output device (Figure 12, column 57 lines 47-65).

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16. Regarding claim 6, Reisman disclosed a media content delivery system wherein said output device comprises an audio output device (Figure 12, column 57 lines 47-65).

17. Regarding claim 7, Reisman disclosed a media content delivery system wherein said output device comprises an electronic interface (Figure 12, column 57 lines 47-65).

18. Regarding claim 8, Reisman disclosed a media content delivery system wherein said external data interface comprises a wire connection (Figure 12, column 30 lines 1-4).

19. Regarding claim 9, Reisman disclosed a media content delivery system further comprising a server connected to said wire connection (Figure 12, column 30 lines 1-4).

20. Regarding claim 10, Reisman disclosed a media content delivery system further comprising a computer connected to said server (Figure 12).

21. Regarding claim 11, Reisman disclosed a media content delivery system wherein said external data interface comprises a wireless connection (column 5 lines 39-47, column 30 lines 1-4).

22. Regarding claim 12, Reisman disclosed a media content delivery system further comprising a server connected to said wireless connection (column 5 lines 39-47, column 30 lines 1-4).

23. Regarding claim 13, Reisman disclosed a media content delivery system further comprising a computer connected to said server (Figure 12, column 5 lines 39-47).

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24. Regarding claim 14, Reisman disclosed a media content delivery system wherein said external data interface comprises a compact disc raid only memory drive (Figure 12, column 57 lines 47-65).

25. Regarding claim 15, Reisman disclosed a media content delivery system wherein said external data interface comprises a digital video disc drive (Figure 12, column 57 lines 47-65).

26. Regarding claim 16, Reisman disclosed a media content delivery system wherein said external data interface comprises a computer disk drive (Figure 12, column 57 lines 47-65).

27. Regarding claim 17, Reisman and Fujimoto combined disclose a media content delivery system as claimed in claim 1, wherein said integrated circuit card interface is adapted to hold an integrated circuit card having encoded thereon criteria identifying an e-mail address, and said external data interface is adapted to receive email for the identified e-mail address (Reisman, column 55 lines 53-53; Fujimoto, column 2 lines 46-65).

28. Regarding claim 18, Fujimoto disclosed a media content delivery system further comprising an integrated circuit card having encoded thereon criteria for accepting media files for storage in said database (Abstract, Figures 1-2, column 2 lines 43-65).

29. Regarding claim 19, Reisman disclosed a media content delivery system wherein the criteria are encrypted (column 8 lines 24-38).

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30. Regarding claim 20, Reisman and Fujimoto combined disclose a media content delivery system wherein the criteria include an e-mail address (Reisman, column 55 lines 53-53; Fujimoto, column 2 lines 46-65).

31. Regarding claim 21, Reisman and Fujimoto combined disclose a media content delivery system further comprising a kiosk housing, said database, said user input device, said output device, said integrated circuit card interface, said external data interface, and said controller (Reisman, Figure 12, column 30 lines 1-4; Fujimoto, Figures 1-2, column 14 lines 41-52).

32. Regarding claim 22, Reisman and Fujimoto combined disclose a process of updating file in a database of a media content delivery system, said process comprising the steps of: receiving at the media content delivery system an integrated circuit card having encoded thereon criteria for selecting media files; receiving at the media content delivery system at least one media file; and storing in the database of the media content delivery system only media files received at the media content delivery system which meet the criteria on the integrated circuit card (Reisman, Figure 12, column 10 lines 52-67; Fujimoto, Abstract, Figures 1-2, column 2 lines 46-65, column 5 lines 47-61, column 9 lines 20-39).

33. Regarding claim 23, Fujimoto disclosed a process wherein step (b) comprises connecting the media content delivery system to an external data source, and receiving the at least one media file from the external data source (Abstract, Figure 1, column 2 lines 46-65).

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34. Regarding claim 24, Reisman disclosed a process wherein step (b) comprises connecting the media content delivery system to the external data source by a wire connection (Figure 12, column 30 lines 1-4).

35. Regarding claim 25, Reisman disclosed a process as claimed in claim 23, wherein step (b) comprises connecting the media content delivery system to the external data source by a wireless connection (Figure 12, column 30 lines 1-4).

36. Regarding claim 26, Reisman disclosed a process wherein step (b) comprises connecting the media content delivery system to a server (Figure 12).

37. Regarding claim 27, Reisman disclosed a process wherein step (b) comprises connecting the media content delivery system to a computer (Figure 12).

38. Regarding claims 28-34, Reisman and Fujimoto combined disclose a process wherein step (b) comprises receiving an audio file, a video file, a video game, a movie, a text file, a newspaper, e-mail file (Reisman, column 20 lines 31-42, column 22 lines 18-31, column 55 lines 53-58; Fujimoto, column 9 lines 29-38).

39. Regarding claim 35, Reisman disclosed a process wherein the media content delivery system includes a compact disc read only memory drive, and step (b) comprises inserting a compact disc read only memory into the compact disc read only memory drive, and receiving the at least one media file from the compact disc read only memory (column 1 lines 34-45, column 41 lines 3-14, column 42 lines 8-17).

40. Regarding claim 36, Reisman disclosed a process wherein the media content delivery system includes a digital video disc drive, and step (b) comprises inserting a

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digital video disc into the digital video disc drive, and receiving the at least one media file from the digital video disc (column 41 lines 3-14, column 42 lines 8-17).

41. Regarding claim 37, Reisman disclosed a process wherein the media content delivery system includes a computer disk drive, and step (b) comprises inserting a computer disk into the computer disk drive, and receiving the at least one media file from the computer disk (Figure 12, column 41 lines 3-14, column 42 lines 8-17).

42. Regarding claim 38, Reisman disclosed a media content delivery system wherein the electronic interface comprises: a mobile wireless device [PDA] using a short-range communication link coupling the mobile wireless device to said database (column 1 line 63-column 2 line 8, column 11 lines 18-31).

43. Regarding claim 39, Reisman disclosed a mobile wireless device [PDA] using a short-range communication link coupling the mobile wireless device to said database (column 1 line 63-column 2 line 8, column 11 lines 18-31). Examiner takes Official Notice (see MPEP § 2144.03) that " wherein the mobile wireless device uses a *Bluetooth link* coupling the mobile wireless device to said database" in a computer networking environment was well known in the art at the time the invention was made as disclosed in Applicant Admitted Prior Art and other prior arts disclosed in the attached PTO-892 form. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)."

Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

44. Regarding claim 40, Fujimoto disclosed a media content delivery system wherein the criteria comprise: an identification of at least one type of file which may be accepted for storage in said database (column 5 lines 47-57, column 5 line 62-column 6 line 14, column 8 line 34-48).

45. Regarding claims 41-45, the limitations of these claims are similar to the limitations of claim 40, and thus are rejected using the same rationale.

46. Since all the limitations of the claimed invention were disclosed by the combination of Reisman and Fujimoto, claims 1-45 are rejected.

Response to Arguments

47. Applicant's arguments filed 09/09/2004 have been fully considered but they are not persuasive.

48. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Reisman suggested exploration of art and/or provided a reason to modify the delivery system with other storage devices such as the integrated circuit (IC) card to enable flexible and appropriate online service charging mechanism for online media products (column 2 lines 39-48, column 10 lines 52-67, column 29 line 62-67, column 62 lines 29-32).

49. It would have been obvious then for one of ordinary skill in the art at the time of the invention was made to modify the delivery system of Reisman with the teachings of Fujimoto to include the IC card feature in order to offer user greater flexibility because IC cards would have the function of checking authenticity and of storing data (Fujimoto, column 1 lines 34-42) since online services are oriented to extended online sessions which require complex user interaction (Reisman, column 2 lines 24-30). In addition, IC cards would also permit an online service provider to incorporate access fee into a purchase price or a product subscription (Reisman, column 2 lines 39-48) since an IC card has logical processing functions such as data generation and logical decision (Fujimoto, column 1 lines 34-43).

50. Furthermore, Reisman disclosed, "While an illustrative embodiment of the invention has been described above, it is, of course, understood that various modifications will be apparent to those of ordinary skill in the art". Reisman also disclosed, "General-purpose online information services do not provide a suitable medium for electronic information publishers to distribute updates, and the like, because

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of limited interface flexibility, because a publisher cannot expect all their customer base to be service subscribers, and because of cost and payment difficulties” and “Online service charging mechanisms are also inflexible and inappropriate for most individual information products, requiring monthly subscription fees of \$5-10 or more, plus time charges for extended use, which are billed directly to users, after a user sign-up and credit acceptance process. Such cost mechanisms are too expensive and too complex for distribution of many products such as magazine and other low cost update products. They do not presently permit a publisher to build an access fee into a purchase price or a product subscription”. To improve these inefficiencies, one of ordinary skills in the art would be motivated to explore other arts for storage devices that have logical processing functions such as data generation and logical decision to enable simple, economical, and prompt mass distribution of electronic information products.

51. In response to applicant's argument that “as illustrated in Fig. 2, area Z1 is purely a storage area, area Z2 is a purchase history data area and area Z3 is an accounting data area which, do not meet the aforementioned limitations. The data area Z3 stores information utilized by the software deliverers 1-3 to determine if the purchaser has a sufficient balance to cover the desired purchase”, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Fujimoto disclosed “

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52. In response to applicant's argument that Fujimoto did not disclose the limitations as claimed in claim 1, the Examiner respectfully asserts that these limitations are disclosed as detailed in the above rejection. In particular, Fujimoto disclosed, "As a result of the collation in step 102, if matched, the process advances to step 103 whereupon it is judged that the purchaser's inherent data/accounting data recorded in the purchaser record medium 13 is normal. Thereafter, the computer of the software deliverer proceeds to the delivery operation which includes the accounting process. In contrast, if not matched, the process advances to step 104 whereupon it is judged that the purchaser's inherent data/accounting data recorded in the purchaser record medium 13 is abnormal. Then, the computer of the software deliverer stops the delivery operation". It would be obvious then that the storage of online products in the purchaser record medium [IC card] is based on the criteria stored on the card.

53. In response to applicant's arguments made in regard to claim 22, applicant stated that "Claim 22 is patentable for the same reason set forth above with respect to claim 1", please refer to the previous response regarding claim 1 for details.

54. In regard to the newly added claims (claims 38-45), the limitations of these claims are rejected as detailed in the above rejection.

55. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

Conclusion

56. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

57. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William Cuchlinski

SPE

Art Unit 2144

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January 31, 2005